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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,624	05/08/2001	Paul Raposo		3680

7590

10/24/2005

Paul Raposo  
2 Townsend Street #1-209  
San Francisco, CA 94107

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/851,624

Applicant(s)

RAPOSO, PAUL

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 5, 2005 has been entered.

Applicant has submitted a substitute specification and additional drawings.

Claims 1-8, 10, 12, and 14 have been amended.

Claims 15-21 have been added.

Claims 1-21 are presented for examination.

2. The previously pending rejection under 35 U.S.C. § 101 is withdrawn.

### ***Response to Arguments***

3. Applicant's arguments filed October 5, 2005 have been fully considered but they are not persuasive.

Applicant submits that the substitute specification and claim amendments overcome all rejections; however, the Examiner respectfully disagrees for the reasons presented in the revised rejections below.

Applicant requests assistance from the Examiner in drafting a claim, as per MPEP 707.07(j); however, the Examiner cannot provide this assistance until allowable subject matter that is fully supported by the original disclosure is identified.

In conclusion, Applicant's arguments are not persuasive.

### ***Specification/Drawings***

4. The amendment filed October 5, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure (including the drawings). 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has made significant amendments to the specification, adding approximately 13 pages of subject matter that is not fully supported by the original disclosure. Principally, Applicant now incorporates various examples of applications of the invention; however, these examples include details that are not described in or inherent to the original disclosure, including the specification and drawings. Recently submitted Figures 2-6 correspond to the subject matter recently incorporated into the specification and are therefore deemed to present new matter as well.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Also, claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as intended by Applicant.

Claims 1-21 recite the indexing of different versions of a survey. The specification lacks adequate written disclosure to explain what is meant by indexing versions of a survey. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? The specification states, "Benchmarks provide a quantifiable way to conceptually grade and measure the success of a survey against goals." (Page 4 of the specification) Again, is the success of a survey measured or do the results of the survey reflect the success of an entity in reaching established goals related to survey questions?

Also, what is meant by designing a survey with goals and weights (see claims 8-14)? Are survey questions literally weighted to reflect a level of importance or are they

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merely chosen to correspond to the information that a survey requester desires to ascertain from the survey results?

In claims 1-21, it is not clear what is meant by indexing surveys. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? What is meant by creating a survey index based on applying goal answer values and weights to the sets of answer values? Furthermore, how does this serve to allow for a comparison of different versions of the survey? If the weights of a variety of questions can be altered for each survey version, how can the success of each survey be benchmarked against another survey with different weights? By weighting each question, the person designing the survey is imparting some sort of bias to each survey. Applicant has compared the index reflecting the success of each survey to a stock market index; however, the stock market is dynamically changing over time and is compared to a desired value. The more a stock is worth, the better it is performing. On the other hand, each survey is based on a different version or selected groups of questions and respective weights for each question. The various surveys seem to present more factors to take into account than assessment of stock market performance. Also, the stock market index is quantifiable in relation to a fixed goal (i.e., the higher the value of the stock, the better it is performing). Surveys are subjective in nature. How does weighting the questions determine if the survey is successful? Is it analogous to scoring a batch of SATs and making the questions either easier or harder or weighting them differently until the average score is 1200? How is the goal of a set

of surveys determined? Is it a subjective goal or a scored goal? The invention recites various weights, goals, and indices; however, no real-world significance is applied to either in a context that explains how any useful comparison of the different versions of a survey is reasonably and consistently achieved. The Examiner has looked toward the specification (especially as originally filed) and has not found sufficient clarification to answer of all of these questions.

Without adequate written disclosure regarding the aforementioned questions, the Examiner submits that one of ordinary skill in the art would not know how to make and/or use the claimed invention, as intended by Applicant.

Appropriate clarification is required.

7. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has made significant amendments to the specification, adding approximately 13 pages of subject matter that is not fully supported by the original disclosure. Principally, Applicant now incorporates various examples of applications of the invention; however, these examples include details that are not described in or inherent to the original disclosure, including the specification and drawings. Amended

and newly added claims 1-21 extensively incorporate this subject matter recently added to the specification and are therefore deemed to present new matter as well.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "such as" (in the third to last line) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claims 1-21, it is not clear what is meant by indexing surveys. Are the survey results used to measure the success of benchmarked goals of a survey requester or does the actual survey itself comprise various versions that are all compared to an original version? What is meant by creating a survey index based on applying goal answer values and weights to the sets of answer values? Furthermore, how does this serve to allow for a comparison of different versions of the survey? If the weights of a variety of questions can be altered for each survey version, how can the success of each survey be benchmarked against another survey with different weights? By weighting each question, the person designing the survey is imparting some sort of bias to each survey. Applicant has compared the index reflecting the success of each survey to a stock market index; however, the stock market is dynamically changing over



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Appropriate correction is required.

10. *Because claims 1-21 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims.*

*See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless*

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*cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.*

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

October 20, 2005